

**REMARKS**

Applicant thanks the Examiner for examining the application. Applicant has amended claims 1, 8, 15, 16, 17, 22, 27, and 28, as described further herein, to expedite prosecution on the merits and to further distinguish the claims from the cited art. Support for the amendment of claims 1, 8, 15, 16, 17, 22, 27, and 28 may be found throughout the specification, and specifically at least on page 12 lines 7-18, page 12 line 19 to page 13 line 4, page 14 lines 6-24, and page 14 line 25 to page 15 line 5. The amendment of claims 1, 8, 15, 16, 17, 22, 27, and 28 thus do not constitute the addition of new matter. Applicant has also canceled dependent claim 30. Applicant files this response with a Request for Continued Examination, and requests that the Examiner contact Applicant's Attorney prior to issuance of the next action to discuss any remaining issues. With these amendments, claims 1-29 and 31-32 are pending.

**Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner rejected claims 1, 3, 7-8, 10, 14-17, 20-22, 24, 26-28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,463,471 to Dreke et al. in view of U.S. Published Patent Application No. 2003/008046 to Mathis.

Applicant's amended independent claim 8 now requires, among other things, receive, from the content subscriber, a subscription request for presence information, wherein the subscription request includes a subscription request for a current value of the presence information and a subscription request for changes in the current value of the presence information; insert an address within a notification message in response to receiving the subscription request, the address relating to the presence information transmitted using a one-to-many transmission channel; and transmit the notification message to the content subscriber, the address of the notification message allowing the content subscriber to subscribe to the presence information using the one-to-many transmission channel, subscribing to the presence information using the one-to-many transmission channel resulting in the content subscriber receiving a current value of the presence information and changes in the current value of the presence information from the computerized device.

The Examiner cited to col. 4 lines 3-12 and 19-48, as well as col. 5 lines 20-21, of Dreke et al. as teaching or suggesting these limitations (except for using a one-to-many transmission channel, which the Examiner makes clear Dreke et al. does not teach). Further, in response to Applicant's previous arguments on this point, the Examiner also cited to col. 5 lines 18-22 of Dreke et al.

However, neither the cited text nor any other text of Dreke et al. teaches or suggests these limitations, which are required by Applicant's amended independent claim 8. Specifically, at no point does Dreke et al. teach or suggest that the subscription request includes a subscription request for a current value of the presence information and a subscription request for changes in the current value of the presence information, and that subscribing to the presence information using the one-to-many transmission channel resulting in the content subscriber receiving a current value of the presence information and changes in the current value of the presence information from the computerized device.

As discussed in detail in Applicant's previous responses, Dreke et al. teaches a system whereby one of a number of peers (designated Peer A in the cited text of Dreke et al.) transmits, from a Internet Presence Information Server (IPIS), a list of peers whose Internet presence are of interest to Peer A, and a request for a list of peers who have told the IPIS that they are interested in the presence of Peer A; see col. 4 lines 5-8. The IPIS then transmits to Peer A a list including "the last known address, such as the IP address for Peer B and Peer C", col. 4 lines 10-12. Peer A then attempts to validate those IP addresses by attempting to contact Peer B and Peer C, respectively, by using those addresses to "ping" those peers, without using the IPIS; see col. 4 lines 19-22 and lines 37-44. Peer A is able to validate the address of Peer C, because Peer C is still online at the IP address sent by the IPIS to Peer A; see col. 4 lines 29-34. Then, Peer A is able to determine if Peer C ever goes offline by periodically "pinging" Peer C, that is, using the well known TCP/IP "ping" command to contact Peer C, and if an appropriate response is received, Peer A knows that Peer C is still online; see col. 4 lines 37-44. Peer C can track those other peers watching Peer C, and will notify such peers when Peer C goes offline; see col. 4 lines 44-48.

This system, however, does not teach or suggest Applicant's amended independent claim 8. Simply stated, there is no subscription request as required by Applicant's amended independent claim 8 taught or suggested by Dreke et al. The IPIS does not receive a subscription request for presence information from Peer A, where the subscription request includes a subscription request for a current value of the presence information and a subscription request for changes in the current value of the presence information, as required by Applicant's amended independent claim 8. Rather, the IPIS receives a **list** of those other peers Peer A wants to be able to contact to determine their presence. A list of peers is not a request for a current value of the presence information, or a request for changes in the current value of the presence information. Indeed, a list of peers merely tells the IPIS which peers Peer A is interested in, and does not indicate to the IPIS that Peer A wants a current value of the presence information of those peers, or changes in the current value of the presence information of those peers. Indeed, this list of peers **cannot** be a request for present information, because the IPIS does not have any presence information to send back to Peer A. As Dreke et al. makes clear, once the IPIS has received Peer A's list, and responded with a list of the IP addresses (which are not values of presence information) of the peers on Peer A's list and a list of peers interested in Peer A, "no further communication between the user [i.e., Peer A] and IPIS is required," *see at least* Abstract. Dreke et al. further makes clear that any presence information on those peers comes from Peer A itself, and not the IPIS; *see at least* col. 4 lines 29-48.

Applicant also respectfully notes that the list of peers sent by Peer A to the IPIS is not a **subscription** request for presence information. A subscription request, by its very name, requires that Peer A performs the act of subscribing for the presence information. That is, Peer A should not just receive presence information back from the IPIS once if it has made a subscription request, but should receive presence information back from the IPIS many times (i.e., over and over – hence the word "subscription"), without Peer A having to take any further action. Entirely apart from the fact that the IPIS does not provide any presence information to Peer A, as shown above and elsewhere herein, the IPIS does not send (1) a list of the IP addresses of the peers on

Peer A's list and (2) a list of peers interested in Peer A lists of peers over and over to Peer A without Peer A taking any further action, but in contrast, does so just once; to get this information from the IPIS again, Peer A would have to transmit its list of peers it is interested in again in a new network session. *See at least* col. 4 lines 3-18.

Further, simply stated, Dreke et al. does not teach or suggest that the content subscriber receives presence information from the computerized device. Indeed, according to the Examiner's argument in the Final Office Action, the IPIS is the computerized device, and Peer A is the content subscriber; *see at least* page 3 item 5 and page 15 item 38. Applicant's amended independent claim 8 requires that subscribing to the presence information using the one-to-many transmission channel results in the content subscriber receiving a current value of the presence information and changes in the current value of the presence information from the computerized device. As demonstrated above, Peer A never receives any value(s) of any presence information from the IPIS, but rather receives a list of IP addresses for peers that Peer A has identified it as being interested in. Peer A then itself acquires the presence information for these peers, not from the IPIS, but from the peers themselves, by pinging those peers; *see at least* col. 4 lines 29-48. Indeed, the whole point of Peer A pinging those peers is to determine their presence, that is, if those peers are online or not; *see id.* Peer A does not subscribe to anything from the IPIS, and does not receive any presence information in response to communicating with the IPIS. The IPIS has no presence information to give Peer A. If it did, why would Peer A go through the processes of pinging the peers to determine their presence online or not, if Peer A could get that information by simply asking the IPIS?

Thus, for at least any of the reasons given above, Dreke et al., either alone or in combination with Mathis, does not teach or suggest Applicant's amended independent claim 8. Therefore, Applicant's amended independent claim 8 is allowable over Dreke et al. in view of Mathis.

Applicant's amended independent claims 1, 15, and 16 all include limitations similar to those of Applicant's allowable amended independent claim 8. Therefore, for at least the reason(s) given above with regards to Applicant's allowable amended independent claim 8, Applicant's amended independent claims 1, 15, and 16 are themselves not obvious in light of Sylvain in view of Mathis, and thus, Applicant's amended independent claims 1, 15, and 16 are allowable over the combination of Sylvain with Mathis.

Further, Applicant's amended independent claims 17, 22, and 27-28 all include limitations similar to those of Applicant's allowable amended independent claim 8, namely, transmitting a second subscription request for the presence information using the one-to-many transmission channel, wherein the second subscription request includes a subscription request for a current value of the presence information and a subscription request for changes in the current value of the presence information; wherein transmission of the second subscription request results in receiving a current value of the presence information and changes in the current value of the presence information from the computerized device. As explained above with regards to Applicant's allowable amended independent claim 8, Dreke et al. fails to teach or suggest these limitations. Thus, for any of the reasons given above with regards to Applicant's allowable amended independent claim 8, Dreke et al., either alone or in combination with Mathis, does not teach or suggest Applicant's amended independent claims 17, 22, and 27-28. Therefore, Applicant's amended independent claims 17, 22, and 27-28 are themselves allowable over Dreke et al. in view of Mathis.

Applicant's dependent claims 3 and 7 depend from Applicant's allowable amended independent claim 1. Applicant's dependent claims 10 and 14 depend from Applicant's allowable amended independent claim 8. Applicant's dependent claims 20-21 depend from Applicant's allowable amended independent claim 17. Applicant's dependent claims 24 and 26 depend from Applicant's allowable amended independent claim 22.

Therefore, for any of the reasons given above, neither Dreke et al. nor Mathis, either alone or in combination, teach or suggest Applicant's dependent claims 3, 7, 10, 14, 20-21, 24, 26, and 30, and thus Applicant's dependent claims 3, 7, 10, 14, 20-21, 24, 26, and 30 are themselves allowable over Dreke et al. in view of Mathis.

The Examiner next rejected claims 2, 9, 18, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Dreke et al. in view of Mathis and further in view of U.S. Published Patent Application No. 2004/0098491 to Costa-Requena et al.

Applicant's dependent claims 2, 9, 18, and 23 depend from, respectively, Applicant's allowable amended independent claims 1, 8, 17, and 22. Therefore, for at least the reason(s) given above with regards to Applicant's allowable amended independent claims 1, 8, 17, and 22, Applicant's dependent claims 2, 9, 18, and 23 are themselves not obvious in light of Dreke et al. in view of Mathis and further in view of Costa-Requena et al., and thus, Applicant's dependent claims 2, 9, 18, and 23 are allowable over the combination of Dreke et al. with Mathis and with Costa-Requena et al.

The Examiner next rejected claims 4 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Dreke et al. in view of Mathis and further in view of U.S. Published Patent Application No. 2003/0115283 to Barbir et al.

Applicant's dependent claims 4 and 11 depend from, respectively, Applicant's allowable amended independent claims 1 and 8. Therefore, for at least the reason(s) given above with regards to Applicant's allowable amended independent claims 1 and 8, Applicant's dependent claims 4 and 11 are themselves not obvious in light of Dreke et al. in view of Mathis and further in view of Barbir et al., and thus, Applicant's dependent claims 4 and 11 are allowable over the combination of Dreke et al. with Mathis and with Barbir et al.

The Examiner next rejected claims 5 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Dreke et al. in view of Mathis in view of Barbir et al. and further in

view of U.S. Published Patent Application No. 2003/0217099 to Bobde et al.

Applicant's dependent claims 5 and 12 depend from, respectively, Applicant's allowable amended independent claims 1 and 8. Therefore, for at least the reason(s) given above with regards to Applicant's allowable amended independent claims 1 and 8, Applicant's dependent claims 5 and 12 are themselves not obvious in light of Dreke et al. in view of Mathis in view of Barbir et al. and further in view of Bobde et al., and thus, Applicant's dependent claims 4 and 11 are allowable over the combination of Dreke et al. with Mathis and with Barbir et al. and with Bobde et al.

The Examiner next rejected claims 6, 13, 19, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Dreke et al. in view of Mathis and further in view of U.S. Patent No. 6,813,501 to Kinnunen et al.

Applicant's dependent claims 6, 13, 19, and 25 depend from, respectively, Applicant's allowable amended independent claims 1, 8, 17, and 22. Therefore, for at least the reason(s) given above with regards to Applicant's allowable amended independent claims 1, 8, 17, and 22, Applicant's dependent claims 6, 13, 19, and 25 are themselves not obvious in light of Dreke et al. in view of Mathis and further in view of Kinnunen et al., and thus, Applicant's dependent claims 6, 13, 19, and 25 are allowable over the combination of Dreke et al. with Mathis and with Kinnunen et al.

The Examiner next rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Dreke et al. in view of Mathis in view of Kinnunen et al. and further in view of Bobde et al. and U.S. Published Patent Application No. 2004/0158608 to Friedman.

Applicant continues to respectfully submit that, when an Examiner needs to combine **five separate references** in order to maintain a rejection of a claim under § 103(a), and the Examiner must also provide proper suggestions or motivations to combine all five references, the Examiner is stretching the term "obvious" past its breaking point. Indeed, Applicant finds it hard to believe that anything requiring a combination of five separate references is obvious. Applicant notes the Examiner's

citation to *In re Gorman*, but further notes that MPEP § 2145 makes clear that, even in light of *In re Gorman*, “Reliance on a large number of references in a rejection does not, **without more**, weigh against the obviousness of the claimed invention” (emphasis added). Indeed, the Federal Circuit in *In re Gorman* itself made clear that “Determination of whether a new combination of known elements would have been obvious to one of ordinary skill depends on various factors”, and that there must be some reason to combine the references; in light of recent case law (that is, the Supreme Court’s 2007 decision in *KSR Int’l v. Teleflex, Inc.*), the Examiner must still show support for the reasoning that a claimed combination is obvious. Here, Applicant offers more, and shows that the Examiner fails to provide support for the claimed obviousness of parts of the combination.

First, regarding the rejection of Applicant’s dependent claim 6, upon which Applicant’s dependent claim 29 is based, the Examiner fails to offer a motivation to combine Dreke et al., Mathis, and Kinnunen et al. that has some reason found in one of those references; see Office Action page 11 item 28. That is, the Examiner makes a statement regarding why the Examiner feels it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of those references, but does not provide any support for that claim, either from one of the references or elsewhere. Second, while the Examiner does provide a reason from one of the references to support the combination of all five references, when the Examiner indicates that it would have been obvious to combine Dreke et al, Mathis, and Kinnunen et al. with Bobde et al., the Examiner there also fails to provide support, either from one of the references, or anywhere else.

In any case, Applicant’s dependent claim 29 depends from Applicant’s allowable amended independent claim 1. Therefore, for at least the reason(s) given above with regards to Applicant’s allowable amended independent claim 1, Applicant’s dependent claim 29 is itself not obvious in light of Dreke et al. in view of Mathis in view of Kinnunen et al. and further in view of Bobde et al. and Friedman, and thus, Applicant’s dependent



claim 29 is allowable over the combination of Dreke et al. with Mathis and with Kinnunen et al. and with Bobde et al. and with Friedman.

Finally, the Examiner rejected claims 31-32 under 35 U.S.C. § 103(a) as being unpatentable over Dreke et al. in view of Mathis and further in view of U.S. Patent No. 6,122,372 to Hughes.

Applicant's dependent claims 31-32 depend from, respectively, Applicant's allowable amended independent claims 1 and 8. Therefore, for at least the reason(s) given above with regards to Applicant's allowable amended independent claims 1 and 8, Applicant's dependent claims 31-32 are themselves not obvious in light of Dreke et al. in view of Mathis in view of Hughes, and thus, Applicant's dependent claims 4 and 11 are allowable over the combination of Dreke et al. with Mathis and with Hughes.

### **CONCLUSION**

Applicant believes this Amendment and Response to be fully responsive to the present Office Action. Thus, based on the foregoing Remarks, Applicant respectfully submits that this application is in condition for allowance. Accordingly, Applicant requests allowance of the application.

Applicant hereby petitions for any extension of time required to maintain the pendency of this case. If there is any fee occasioned by this response that is not paid, please charge any deficiency to Deposit Account No. 50-3735.

Should the enclosed papers or fees be considered incomplete, Applicant respectfully requests that the Patent Office contact the undersigned collect at the telephone number provided below.

Applicant invites the Examiner to contact the Applicant's undersigned Attorney if any issues are deemed to remain prior to allowance.

Respectfully submitted,

                    /SPM/                    

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